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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,503	07/06/2001	Patrick Remery	15675P351	3947

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EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/787,503

Applicant(s)

REMERY ET AL. 

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

Applicant: Remery et al.

Filing date: 7/7/2001

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

5 Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10 Claims 1-3 and 10-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Amended claim 1 reads "said first counter being named aggregate of small accounts counter". Names of useful elements are not patentable subject matter. The counter could be named "collection of small accounts counter" and it would function equivalently. If Applicant were to replace the word "named" with the word "an", this rejection would be withdrawn.

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Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

20 Claims 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

25 Claims 18 to 20 appear to claim a chip card or terminal, but recite dependencies on claim 1, which is directed to a process. It is unclear whether Applicant is claiming an apparatus or a process. Moreover, since claims 18-19 claim a chip card, and claim 1 is directed towards a process which involves a chip card, a terminal, and an online bank, it is unclear which "means" applicant is claiming. A similar problem exists for terminal claim 20.

Re claim 19, the recitation "and/or" is indefinite, since "/" is not standard English.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 10, and 18-20 are rejected under 35 U.S.C. § 102(a) as being anticipated by EP 0829,830 to Hirokawa ("Hirokawa" hereinafter). Hirokawa discloses a process for managing an electronic transaction by means of a bank card of the category with a microprocessor chip (IC card C), and of reading a terminal (3) able to interact with said card, in which the reading terminal sends a signal (via IC Card reader writer 37) to said card which indicates thereto the amount of the transaction (S214) and in which said card performs a first comparison step where it compares this amount with a first threshold value (s217) and instigates a bearer authentication procedure (s220) when this amount is above said first threshold, wherein, when the amount of the transaction is below first said threshold, said chip card performs a second comparison step (s218) where it compares with a second threshold value an incremented value of a first counter, said first counter being an aggregate of small amounts counter and being successively incremented by values of amounts of transaction in cases where said amounts are below said first threshold, said incremented value corresponding to the previous value of said first counter, incremented by the value of the amount of transaction, and wherein a procedure for authenticating the bearer of the card is instigated (s220) by said card depending on the result of this second comparison (if S218 = NO) (see especially figure 4).

Re claims 3 and 10, the first counter stores the incremented value both before and after the second comparison step.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14 and 16 are rejected under 35 U.S.C. § 103 as being unpatentable over Hirokawa. Hirokawa does not specify either "positive" or "negative" incrementation. However, positive and negative are relative terminology. The skilled artisan would view positive or negative incrementation as functional equivalents. Moreover, without a definition of what a positive symbol is, and what a negative symbol is, the claims do not distinguish a real difference. In other words, the artisan could define 00010010 as either a positive or a negative number, by convention, and it would not change how the device operates. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use either positive incrementation or negative incrementation in Hirokawa, because the two are functionally equivalent, and the result of a symbolic naming convention only. As long as the artisan picks one or the other and sticks with the chosen convention, it will not make a difference.

Claims 11-13, 15, and 17, are rejected under 35 U.S.C. § 103 as being unpatentable Hirokawa in view of "Smart Cards", page 52, by Allen and Barr. Hirokawa teaches the features of the invention as described above, and further teaches the use of stored value on the card. Hirokawa teaches that value can be loaded onto the card via an online transaction. See column 1, lines 8-16. Hirokawa teaches the "transaction process" in figure 6, but does not go into great detail about that process. As is well understood in the art, a card user must have a sufficient balance on the card in order to make a given transaction, whether the balance is online or stored

on the card. In the case of Hirokawa, the balance is stored at 51. This balance represents a threshold for the highest possible transaction that the card can perform. If the balance value of 51 is \$60, for example, a transaction amount of \$70 cannot proceed using balance value 51 stored on the card. Again, this is a fundamental understanding in the card arts. "Smart Cards", a book about smart cards, provides evidence that it is well known in the art to "reload" the stored value on a card from a credit line with a bank. One obvious process, when the stored balance of the card is insufficient to process a desired transaction, is to go online to the credit company to "reload" the card, increasing the value above the needed limit to process the desired transaction. So, if the balance on the card is \$60, and the customer wishes to purchase \$70 worth of goods, then the terminal would allow the customer to access their on-line credit account to "reload" the card with at least \$10, in order to make the desired transaction. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have a third threshold value (the balance on the card) wherein transactions above the third threshold would cause the card to instigate a reloading procedure which would require interrogation by the reading terminal of an on-line credit authorization center which would allow the card to be "reloaded" with the appropriate amount of credit, because this would allow the user to purchase items above the current stored value on the card, using their on-line credit line, as taught by "Smart Cards".

Remarks

Applicant argues that "Hirokawa, however, does not concern bank credit cards. Instead, Hirokawa concerns electronic purses...". The Examiner respectfully disagrees with this line of reasoning. The Applicant attempts to draw a false distinction between "electronic purses" and "bank credit cards". In column 1, lines 10-11, Hirokawa clearly treats "allowed credit" the same as the "purchase" of credit. In the smart card art, if stored value is on the card, there is no functional difference whether the bank has allowed the customer access to the stored value based on a pre-paid or post-paid status. The value stored on the card is credit, either way, whether it is "allowed" or "purchased". Hirokawa makes no distinction, and there is no functional distinction as far as the smart card, the terminal, and the on-line bank are concerned.

Applicant also argues that "electronic purses have drawbacks." However, the Applicant

does not provide a specific supporting argument. References to "the bank credit card transaction protocol" are unsupported. Which bank credit card transaction protocol? There are numerous bank credit card transaction protocols in existence throughout the world. Likewise with respect to "the existing infrastructure".

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Voice

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Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

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**MARK TREMBLAY
PRIMARY EXAMINER**

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March 10, 2003